

### ***Remarks***

Reconsideration of this Application is respectfully requested.

Applicants hereby cancel claim 16.

Claims 5-10, 12-15, 17, and 18 are under consideration, with claims 5, 8 and 14 being independent claims. Claims 1-4 were originally filed. Claims 5-10 were added in the amendment filed February 8, 2004, claims 11-13 were added in the amendment filed July 19, 2004 and claims 14-18 were added in the amendment filed June 29, 2005. Claim 4 was cancelled in the amendment filed February 8, 2004, claims 1-3 and 11 were cancelled in the amendment filed June 29, 2005 and claim 16 cancelled herein.

Applicant notes that the cited reference, Bledstein (U.S. Patent No. 5,701,892) has never been listed on a PTO 892 form and was not provided to the applicant. Applicant requests that the references be properly cited on PAIR, so that applicants will be able to download copies of the references.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

### ***Objection to Drawings***

The Examiner objected to the drawings under 37 C.F.R. 1.83(a), presumably regarding Claim 16, the claim has been canceled, thus new drawings are not thought to be necessary.

### ***Rejection of Claims under 35 U.S.C. 112, First Paragraph***

The Examiner has rejected claim 16 under 35 U.S.C. 112, first paragraph as not enabling one of skill in the art to make and/or use the invention. The applicants draws the attention of the Examiner to page 7, second paragraph, where the Examiner has rejected claim 16 as being

obvious. The Applicant requests clarification as to how a claim can be rejected as non-enabling to one of skill in the art, yet also obvious to one of ordinary skill in the art?

Claim 16 has been cancelled, without agreeing to the assertions of the examiner, thus rendering the rejection moot.

***Rejection of Claims under 35 U.S.C. 103(a)***

The Examiner rejected has maintained the rejection of claims 5-10, 12, and 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Hudson (U.S. Patent No. 2,843,121) in view of Bledstein (U.S. Patent No. 5,701,892).

The Examiner stated that regarding claims 5, 7, 8 and 10, “Hudson teaches an oxygen mask 10 having a means for being secured over the nose and mouth of a patient comprising: an elastic band, points of attachment 15 on both sides of the mask, and the elastic band securable to the patient by pulling the ends anteriorally through the points of attachment (col. 2., lines 27-31).” The Examiner also stated the Hudson fails to teach a pair of bands extendible to loop over and around each ear of the patient.

The Examiner further stated that “Bledstein teaches a mask that uses a pair of bands affixed at four points of attachment and extendible to loop over and around each ear of a patient. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace band 17 with ear loops of Bledstein to prevent entanglement of bands in a user’s hair, glasses, or hat and to make it easy to put on (col. 2, lines 32-33 and col. 6, line 10-17).”

The Examiner also stated regarding claims 6 and 9, “Hudson/Bledstein teaches wherein the elastic bands are affixed at four separate points on the mask.” Regarding claim 14, the Examiner states that Hudson teaches an oxygen mask for use on a patient, the oxygen mask

comprising: a face mask molded from plastic comprising a larger part of the mask defined by a face-conforming periphery, a rim with an enlargement configured to substantially conform to the contour of the nose bridge of the patient a first side portion and an opposite second portion configured to substantially conform to contour of the face of the patient, and a lower portion configured to substantially conform to contour of the face of the patient below the mouth so as to form a breathing chamber about the mouth and nostrils of the patient. It should be noted that Hudson fails to teach a pair of bands extendible to loop over and around each ear of the patient.”

The Examiner also stated that “Bledstein teaches a mask that uses a pair of bands affixed at four points of attachment and extendible to loop over and around each ear of a patient. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace band 17 with ear loops of Bledstein to prevent entanglement of bands in a user’s hair, glasses, or hat and to make it easy to put on (col. 2, lines 32-33 and col. 6, line 10-17).”

The Examiner also states regarding claims 6 and 9, “Hudson/Bledstein teaches wherein the elastic bands are affixed at four separate points on the mask.” Regarding claim 14, the Examiner also asserted that “Hudson/Bledstein teaches that both ends of the straps are adjustably connected to the face mask (col. 2, lines 20-31).”

Regarding claim 15, the Examiner states that “Hudson/Bledstein teaches the oxygen mask of claim 14, teaches [sic] wherein both ends of the straps is adjustably connected to the face mask (col. 2, lines 20-31).”

Regarding claim 17, the Examiner states that Hudson/Bledstein teaches the oxygen mask of claim 14, which additionally comprises an adaptor plug 23.

The Applicant respectfully disagree. The Examiner continues to fail to address the additional limitations of claim 5, 7, 8 and 10: 1) a *pair* of elastic bands, 2) *both ends of each pair* affixed at points of attachment to each of both sides of said oxygen mask, said bands extendible to loop over and around each ear of the patient *and* 3) adjustably securable to said patient by pulling the ends anteriorally through said points of attachment. Hudson only has *one pair* of elastic bands and does not disclose *a pair* of elastic bands on each side, as required by the claims. Also, Applicants note that col. 2, lines 36-38 states that the comfortable wearing position is “just below the ears,” which teaches away from the invention, which requires that the bands extend to loop over and around each ear of the patient, as included in independent claims 5, 8 and 14.

The Examiner attempts to cure the deficiency of Hudson by applying Bledstein. The Applicants point out that the ear loops of Bledstein are not adjustable, as required in the claims, nor would one of ordinary skill in the art be motivated to combine the mask of Bledstein, which is a cold weather mask, with the mask of Hudson, one of only medical utility. Additionally, col. 2, lines 32-34 refers not to the mask of the ‘892 Bledstein patent, but rather to the Maryyanek (U.S. Patent No. 4,600,002) in the “Background of the Invention,” and thus provides one of ordinary skill in the art no motivation to combine Bledstein with Hudson. Additionally, in col. 6, line 16-17 states that the ear loops are *permanently attached*, which teaches away from the invention, which requires adjustable straps. Also, the Examiner appears to be requiring that the ends of the adjustable band NOT be permanently attached as evidenced by his rejection under 35 U.S.C. 112, first paragraph, on page 3 of the March 16, 2006 Office Action, where he states that “[t]he specification does not disclose wherein a second end of a strap is permanently attached.” It appears that the Examiner is inexplicably applying a reference requiring a limitation he believes to have insufficient written description in the instant specification. The examiner is

merely lumping many different aspects of several patents together and uses the Applicant's own disclosure to guide him in reconstructing the applicant's invention. Applicants continue to assert that the Examiner continues to apply hindsight reconstruction to arrive at the Applicant's invention.

Regarding the dependent claims, as the Examiner has not established a *prima facie* case of obviousness in the independent claims 5, 8 and 14, the Examiner's comments regarding the dependent claims cannot stand.

MPEP §2143.01 states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Also, the Federal Circuit stated, that the USPTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

In *In re Geiger*, (815 F.2d 686, 690, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987).

Under § 103, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art as to why one of ordinary skill would have been motivated to combine the teachings of the references to arrive at the claimed invention. *In re Regel*, 188 USPQ 132 (CCPA 1975).

The Federal Circuit has also stated:

When resolving an obviousness issue, "the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). Care must be taken to avoid hindsight reconstruction by using "the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit." *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983). [underline by applicants]

*Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

*In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) states:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

The court concludes that if a prior art reference requires some modification in order to meet the claimed invention and such a modification "*rendered [the invention] inoperable for its intended purpose*" one of ordinary skill in the art would not have made the claimed modification, then the modification set forth by the Examiner is not proper and the *prima facie* case of obviousness cannot be properly made. In the present case, the permanently attached ear loops of the winter mask of Bledstein would not provide the purpose and function of the mask of the invention. The straps of the invention, both pairs of straps around the ears, must be adjustable in order to hold the mask close to the wearer's face, to deliver the proper amount of oxygen. Substituting the single adjustable strap, which is designed to fall below the ears, with straps from a winter mask that is not adjustable, is improper hindsight. Additionally, the Examiner has not provided a teaching in the references, each and every limitation of the claim.

Therefore, the PTO has failed to establish a *prima facie* case of obviousness.

Regarding the rejection of claims 6 and 9, the Applicant asserts that the Examiner has failed to set forth a proper *prima facie* case of obviousness for the independent claims 5, 8 and 14, based upon the failure to address all the limitations of the claims and the Applicants assert that the Examiner has used forbidden hindsight reconstruction to craft the rejections. Therefore, rejection of the dependent claims cannot stand.

Regarding claims 15 and 17,<sup>1</sup> paragraphs 11-14 explains the rationale for rejection of claims 15 and 17, which are not recited in the rejection in paragraph 5. If the Examiner intended to include the claims into the rejection in paragraph 5, then the Applicant's rely on arguments regarding the lack of a *prima facie* case in the independent claims, *supra*.

The Examiner also rejected claims 12, 13 and 18 under 35 U.S.C. 103(a) as "being unpatentable over Hudson/Bledstein, as applied to the claims above and further in view of Laanen et al." (U.S. Patent No. 4,865,027)."

The Examiner restated the rejection over Hudson and Bledstein and additionally applied Laanen ('027 Patent) as reciting a "common valve to vent exhaled gases." The Applicant asserts that that the Examiner has failed to set forth a proper *prima facie* case of obviousness for the independent claims 5, 8 and 14, based upon the failure to address all the limitations of the claims and the Applicants also assert that the Examiner has used forbidden hindsight reconstruction to craft the rejections. Therefore, rejection of the dependent claims cannot stand.

The Examiner rejected claim 16 under 35 U.S.C. 103(a) as "being unpatentable over Hudson/Bledstein as applied to the claims above, and further in view of Dyrud et al." (U.S.

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<sup>1</sup> The Applicants assume that the Examiner intended to include the rejection he set forth over independent base claim 14 into the rejection of claims 15 and 17.

Patent No. 5,819,731).

The Examiner states that “Dyrud et al. teaches a mask with a common [sic] one end of each strap is adjustable [sic] connected to a face mask, and the second end of each strap is *permanently attached*.” [emphasis added by Applicant]

The ‘731 patent by Dyrud et al. has been previously addressed by Applicants, and does not cure the deficiency of Hudson due to the requirement in Dyrud et al. to have a strap that goes around the back of the neck, as shown on the face of the patent. This requirement teaches away from the Applicant’s invention. Also, the Examiner appears to be requiring that the ends of the adjustable band NOT be permanently attached as evidenced by his rejection under 35 U.S.C. 112, first paragraph, on page 3 of the March 16, 2006 Office Action, where he states that “[t]he specification does not disclose wherein a second end of a strap is permanently attached.” It appears that the Examiner is inexplicably applying a reference requiring a limitation he believes to have insufficient written description in the instant specification. The Applicant additionally asserts that the Examiner has failed to set forth a proper *prima facie* case of obviousness for the independent claims 5, 8 and 14, based upon the failure to address all the limitations of the claims and the Applicants assert that the Examiner has used forbidden hindsight reconstruction to craft the rejections. Therefore, rejection of the dependent claim 16 cannot stand.

Therefore, the Applicant asserts that in all outstanding obviousness rejections, that the Examiner has failed to set forth a proper *prima facie* case of obviousness based upon the failure to address all the limitations of the claims and the Applicants assert that the Examiner has used forbidden hindsight reconstruction to craft the rejections.

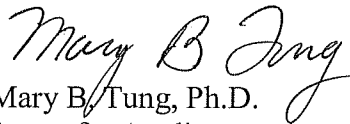


### *Conclusion*

Claims 5-10, 12-15, 17 and 18 are under consideration by the Examiner. In view of the above remarks, Applicant respectfully submits that the application and claims are in condition for allowance, and request that the Examiner reconsider and withdraw the objections and rejections. Applicant believes that a full and complete reply has been made to the outstanding Office action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

  
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